

### **REMARKS**

This is in response to the Office Action dated July 7, 2006. A request for a one month extension of time and the required fee are enclosed. Also submitted herewith are the decision of the United States Court of Appeals for the Federal Circuit in Newell Window Finishings, Inc. v. Springs Window Fashions Division, Inc., dated July 2, 2001, Declaration of John T. Schnebly dated June 22, 2004, and a portion of the prosecution history of United States Patent No. 5,692,550. These attachments are labeled A, B and C, respectively.

### **SUMMARY OF THE INTERVIEW**

Applicant thanks the Examiner for the personal interview on September 10. The Interview Summary prepared by the Examiner accurately describes the discussion and the references discussed. Applicant proposed to amend claim 11 in the manner being done by the present amendment. It was agreed that this amendment overcomes the 102 rejection.

Applicant's counsel showed the Examiner the Declaration of John T. Schnebly which is attached and which has been filed in related application Serial No. 08/726,282. That declaration describes the creation of the Rosette which has been cited by the Examiner. Applicant's counsel pointed out that this declaration demonstrates that those skilled in the art would not be lead to combine the Rosette with the prior art discussed in Figure 2 of United States Patent No. 5,193,601 of Corey et al. to reach the pleaded shade of the amended claims. It was agreed that applicant would present the reasons as to why the claims as amended are patentable under Section 103 in this amendment.

### **The Claims as Amended are Patentable Under Section 103**

Applicant has amended all the claims to define the invention as "a multi-cellular pleated shade for covering a window" rather than a "multi-cellular pleated shade member." This change is significant in view of the decision of the Court of Appeals for the Federal Circuit in the Newell case. At page 9 of the opinion the court distinguished a "pleated cellular shade member" from a "cellular shade for covering a window." A pleated cellular shade member was defined as "three or more cells, with at least one of those cells meeting the described claim limitations." In contrast, a cellular shade "for covering a window" is "not simply the 'shade member,' "but rather a complete shade assembly that covers a window."

The Examiner has rejected claims 11-17 under Section 10-3 as being patentable over Corey et al. '601 in view of the Rosette. As noted by the Examiner, Figure 2 of Corey discloses a multi-cellular shade having tabs on both sides of the shade. Each cell is made of two sheets of material laid horizontally on top of one another and glued together at their ends to form tabs. There is no teaching that cells be made by folding the outer wall to form a pleat on one face and a tab on the opposite face.

The claims in issue in the Newell case were directed to a pleated "cellular shade member" which was construed to mean cellular shade fabric containing three or more cells." The Rosette was a small piece of cellular fabric containing 5 cells as shown in the Schnebly declaration. Consequently, the Rosette is a "cellular shade member" and served as the principal reference in the Court's analysis.

The present claims are directed to a multi-cellular pleated shade for covering a window. Corey et al. disclose a multi-cellular pleated shade for covering a window and is the principal cited reference. The issue is whether one skilled in the art would be motivated to modify the

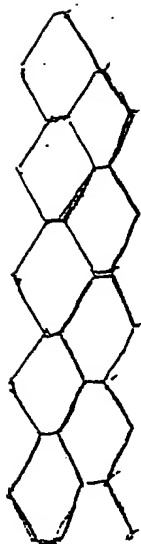
shade in Figure 2 of Corey et al., which has cells formed of two sheets with tabs on both ends, to create a shade having cells made from one sheet of material folded back to form a pleat and attached together to form a tab. Applicant submits that the answer to that question is "No."

The Rosette is a small piece of fabric used to cover the opening at the center of an arch blind or circular blind. This piece of fabric, that came to be called the "Rosette", was created by John Schnebly and his colleagues at Comfortex Corporation in 1992. John Schnebly who did not testify in the Newell case, describes the Rosette as follows:

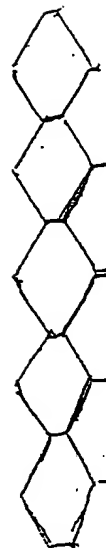
While at Comfortex, I, working in conjunction with others, concluded that we could make from pieces of our Symphony double cell material a structure to cover the opening in an arch blind. This structure came to be called the Rosette. At that time Comfortex made custom window coverings to fit windows whose dimensions were provided by the customer. In making these products we cut segments of double cell material from large stacks or blankets of double cell material. Each segment was sized to correspond to the dimensions provided by the customer. After one or more segments were cut from a blanket we often had pieces of double cell material that were too small to be used as a window covering. We took one of these left over pieces of material and removed one face of the material by cutting the piece parallel to that face using a box knife. The resulting piece of material had a height of from 1 to 3 inches, a width of about 1½ inch and a length that was never more than 4 inches. Then we fanned the cut cellular product to create a semicircular structure which would fit over the opening in the arch blind. Attached is a drawing showing a side view of a portion of our double cell product, that same portion cut to form the Rosette and the same portion fanned to fit into the opening of an arch shade. Because the Rosette was made from a small piece of double cell material and only the end of the material was visible when the Rosette was installed, this product could be made from scrap pieces of our double cell material.

We did not consider the Rosette to be a window covering product or a cellular pleated shade member any more than the plastic inserts previously used to cover the opening in an arch blind would be considered a window covering product or a cellular pleated shade member."

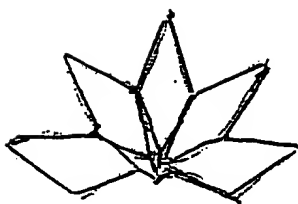
(Schnebly decl., pgs. 2-3). The drawing to which Mr. Schnebly refers is presented on the following page 7. The next page 8 is a set of drawings showing a typical arch blind with and without the Rosette.



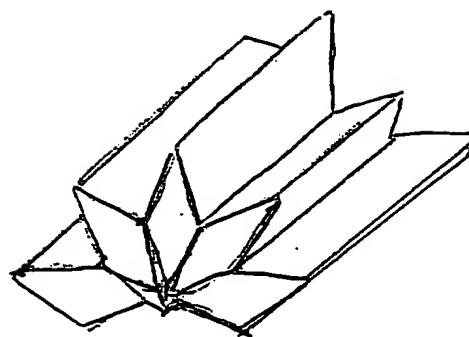
Piece of Symphony  
double cell material



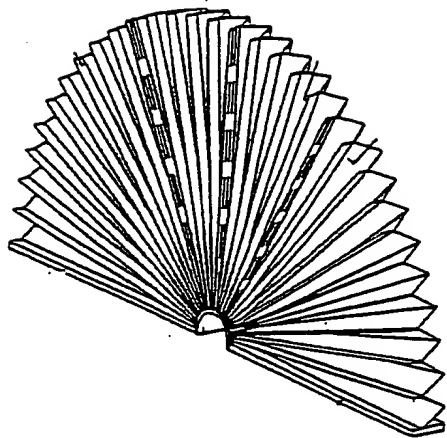
Piece of Symphony  
double cell material  
after being cut



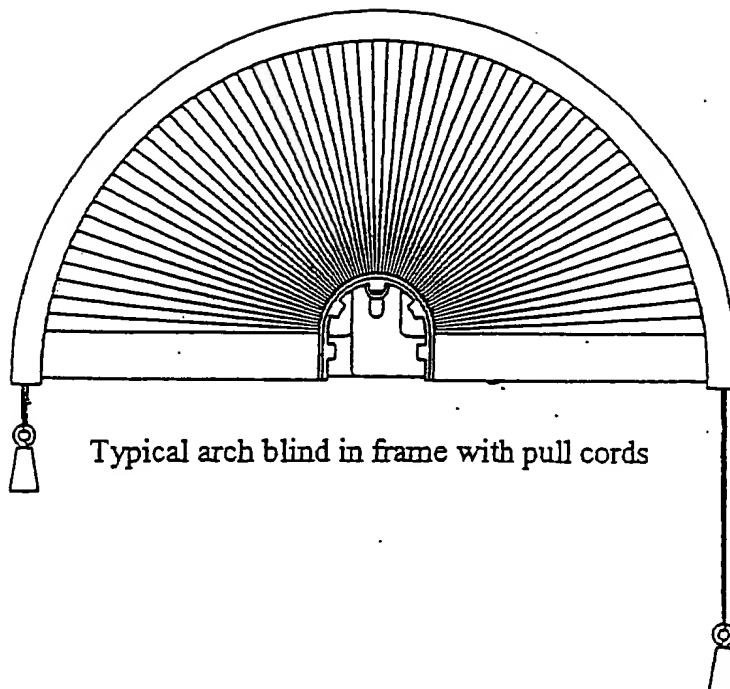
End view of Rosette



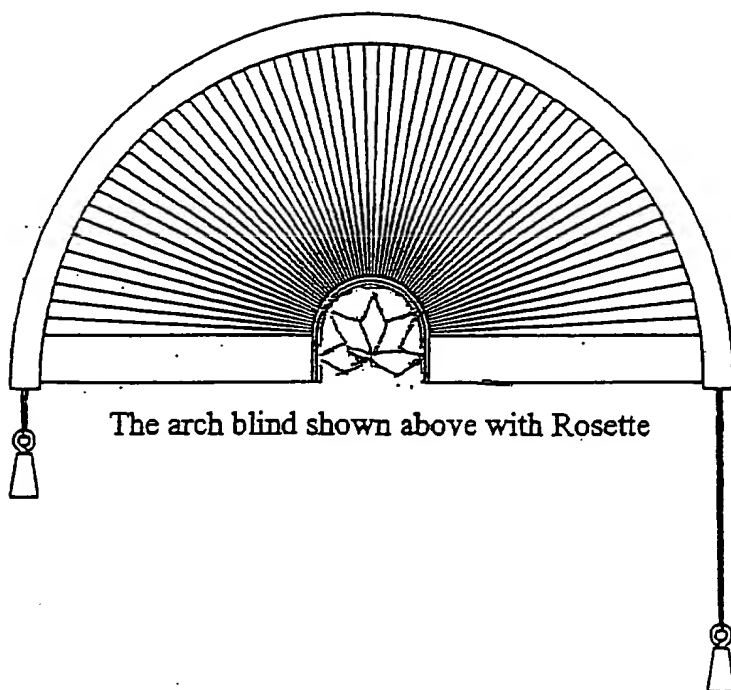
Perspective view of the Rosette



Typical arch blind



Typical arch blind in frame with pull cords



The arch blind shown above with Rosette

Also presented herewith is a portion of the prosecution history of U.S. Patent No. 5,692,550<sup>1</sup> which was presented to the Federal Circuit in the Newell case relevant to the Rosette. At page 10 of the relevant response filed in the '550 patent (pages A005456-A005460 of the Newell appendix - *Attachment C*), there is quoted a Declaration of Dorothy Collins, a Declaration of James Ford and a Declaration of Ronald Presdorf. This portion of the response is reproduced below.

. . . The rosette is a semi-circular "decorative façade"<sup>2</sup> used in conjunction with various window treatments. It is not within the field of cellular window shades, and it is not pertinent to the problems related to the design and manufacture of cellular window shades. The fact that the rosette represents non-analogous art to the field of window shades is clearly supported by the record. For example, Dorothy L. Collins, a designer and consultant with a specialty in windows and window treatments, states in her declaration that:

"A rosette, however, is not a window shade. It is ludicrous to suggest that a rosette is in any way analogous to a window shade, or that a window shade designer looks to rosettes as the inspiration for a new window shade design." (¶ 5)

"No one in the industry, and no consumer, would ever use a rosette as a window shade because a rosette does not perform the function of a window shade. Indeed, rosettes are designed merely to provide a decorative flair to a window shade or to any other window treatment product with which the rosette is used." (¶ 6)

"When a window shade is fully extended, it blocks the light entering a home through that window and provides privacy for the home's occupants. A rosette, however, can only cover a fraction of a window's surface area and thereby does not block the light

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<sup>1</sup> This patent is one of the patents that was involved in Interference Nos. 104,328 and 104,329.

<sup>2</sup> Comfortex, the manufacturer of the Rosette, itself refers to the Rosette, or more specifically a double-celled Rosette, as a "decorative facade." This can be seen, for example, in U.S. Patent No. 4,934,436, which is assigned to Comfortex: "[r]eference being had to Fig. 3C, the invention is therein exhibited in the fully deployed fan mode and lacks only the finishing touch of a decorative facade to cover the space A that exists at the radial center of the shade because of the absence of shade material directly above the joint network." Col. 8, lns. 44-49 (*emphasis added*).

entering the home and does not provide any privacy for the home's occupants." (§ 7)

"When a window shade is fully retracted, it allows light to enter the home unimpeded and lets the home's occupants have a clear view through the window. A rosette, however, cannot be retracted; it is a fixed decorative piece and is not designed to be adjusted." (§ 8)

"A window shade also has some sort of pull mechanism (typically a pull cord) to allow the owner of the home to adjust the position of the shade from a fully retracted position to a fully extended position. In this manner, the owner can leave the shade in any number of partially-opened positions and thereby regulate the amount of light entering the home. A rosette, however, lacks any means by which the owner can adjust its position. Instead, it is a fixed decoration, much like the valence one might hang above their drapes." (§ 9)

"No one in the window treatment industry would call a rosette a window shade, and no one would ever suggest to a customer that a rosette was anything other than an accessory to be used with a window shade." (§ 10)

"As a designer, I would not look to rosettes for ideas about how to make a new window shade design. It is also my professional opinion that no designer would study a rosette for ideas as to a new window shade design." (§ 11)

Similarly, James A. Ford, having more than 35 years experience in the design and manufacture of window treatments and window coverings hardware, states the following in his declaration:

"Based on my 35 years experience in the design and manufacture of window treatments, including window shades, and as an active member in the window dressings trade during this time, it is my opinion that 'rosette' window accessories are not even remotely considered to be 'window shades' within the window treatment community. As such, as a designer of window shades, I would not look to 'rosettes' as an inspiration for new window shade designs. Furthermore, in my opinion, no one in the trade of designing window shades would look to rosettes for such inspiration." (§ 8)

Ronald L. Presdorf, having 20 years experience in the design and manufacture of window shades, states the following in his declaration:

"The rosette is not a window shade and cannot function as a window shade. Rather, the rosette is a four-sided cellular structure that functions [*sic*] as a decorative element to be used in conjunction with various window treatments." (¶ 4)

"I would not consider a rosette as the basis for arriving at a new window shade design because the rosette is separate and distinct from the field of window shade design and manufacture. Moreover, the rosette does not address the problems sought to be overcome in the design of window shades. Consequently, no one in the field of shade design and manufacture would look to rosettes for inspiration in developing new window shades." (¶ 5)

The consistent view of persons skilled in the art and quoted above is that the Rosette is not a window shade and cannot function as a window shade. The Rosette is a "decorative façade" used to plug an opening in an arch blind.

The testimony is also consistent in saying that those skilled in the art would not consider the Rosette in designing a window shade. Dorothy Collins said "[N]o designer would study a rosette for ideas as to a new window shade design." James Ford declared that as a designer of window shades he "would not look to 'rosettes' as an inspiration for new window shade designs. Furthermore, in my opinion, no one in the trade of designing window shades would look at rosettes for such inspiration." Ronald Presdorf also declared that he would not consider a rosette in creating a new window shade design and said, "no one in the field of shade design and manufacture would look to rosettes for inspiration in developing new window shades." Finally, John Schnebly, the creator of the Rosette, declared that, "a tabbed cellular window covering product was not obvious to me from either our Rosette, the Duette single cell or other cellular products in the marketplace." (p. 4).

Four window shade designers who have no interest in the present application all say that they would not consider the Rosette in designing shades. Therefore, it is inappropriate for the Examiner to rely upon the Rosette in rejecting the present claims. Section 103 requires that the



subject matter as a whole would have been obvious to a person of ordinary skill in the art to which the subject matter pertains. This testimony demonstrates that the standard of Section 103 has not been met.

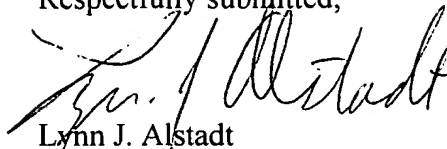
Oftentimes Examiners will combine references on the basis that the references are all directed to similar subject matter. In the Newell case the claims were directed to a cellular fabric having at least three cells. The Rosette is a cellular fabric having five cells and was a proper reference in the claims at issue in Newell. Here the claims are directed to a multi-cellular pleated shade for covering a window. Because the two references are not directed to the same subject matter, the references themselves do not provide a basis for combining the Corey et al. with the Rosette.

It is only through improper hindsight that one can combine the Corey reference with the Rosette to reach the shade for covering a window of the claims as amended in this application. That approach has been consistently rejected by the Courts.

The claims as amended are allowable because it would not have been obvious to persons of ordinary skill in the art to look to the Rosette in designing a shade for covering a window. There is no teaching or suggestion in the Corey reference to make the cells of a single sheet folded back and having its free ends attached to form a tab. Indeed, if there is any teaching or suggestion in the Corey reference to modify the cellular product in Figure 2 that teaching or suggestion is to create a cellular shade having no tabs such as is shown in the other figures of the Corey reference.

For the foregoing reasons, the claims as amended are patentable. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lynn J. Alstadt", written over the printed name.

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